

Appl. No.: 10/826,451
Art Unit: 2882 Docket No.: B04-21
Reply to Office Action of November 12, 2004

REMARKS

Claims 1-4 and 6-15 appear in this application for the Examiner's review and consideration.

Claim 1 has been amended to recite the subject matter of claim 5. Claims 2 and 3 have been amended to correct the units of X-ray intensity. Claims 6-9, 11, and 12 have been amended to correct their dependencies. Claims 5 and 16 have been cancelled.

No new matter has been added by these amendments and additions.

Rejection Under 35 U.S.C. § 112

The disclosure was objected to under 35 U.S.C. § 112 for allegedly failing to provide an adequate written description. Applicant respectfully submits that one skilled in the art would readily understand that Kv is equivalent to keV (*i.e.*, that 1 eV is the energy inherent in a single electron being accelerated across a 1-V potential; and kV is the voltage used to accelerate electrons in the X-ray head). While Applicant is under no requirement to conform the claims to what is considered "conventional terminology," in an effort to clarify the claims, independent claim 1 has been amended to recite keV rather than kV.

The rejection under 35 U.S.C. § 112 is therefore believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

Rejection Over Marshall In View of Wolbarst

Claims 1-4 and 13-16 were rejected under 35 U.S.C. § 103(a) as being obvious over Marshall in view of Wolbarst. Marshall is generally directed to "a method for determining concentricity of a golf ball having a barium or bismuth doped boundary layer or [alternatively] cover." The golf ball is irradiated within an "X-ray imaging machine to image the doped boundary layer relative to the cover and the core to determine the thickness of the cover" or the "concentricity of the boundary layer and cover relative to the core."

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior

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art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The combination of the prior art references fail to disclose or even suggest all the claim limitations of the present invention. As the Examiner acknowledges in the Office Action, Marshall does not mention the X-ray focal spot size or energy beam. Applicant further asserts that Marshall, and the combination with Wolbarst, also fail to disclose providing a marker placed within the measuring holder so that a reference point for measurement is present, regardless of the presence of a barium or bismuth doped golf ball layer, as now recited in claim 1 of the present invention.

It is well held that a *prima facie* case of obviousness can be rebutted if Applicant can show that the cited reference, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 43 U.S.P.Q.2d 1362, 1365 (Fed. Cir. 1997). The reference may further be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be led in a direction divergent from the path that was taken by Applicant. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 U.S.P.Q.2d 1294, 1298 (Fed. Cir. 1999).

Applicant respectfully submits that Marshall *teaches* away from the present invention. Marshall teaches doping of golf ball layers to provide contrast for X-ray imaging – this is not the present invention and Wolbarst does not cure this deficiency. Certainly one of ordinary skill in the art would recognize that *without* doping their layers with bismuth or barium compounds, there would be no way to distinguish the discrete layers of the golf ball. In fact, Applicant described this problem in more detail on pages 4-5 of the Specification and in FIGS. 5-6. There is no way to know whether doping with such compounds adversely affects golf ball performance. The method of the present invention avoids this issue altogether.

For at least the above reasons, the rejection under 35 U.S.C. § 103(a) is believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

Obviousness-Type Double Patenting

Claims 5-12 were rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,757,353 in view of Wolbarst. While Applicant disagrees with this rejection based on the differing scope and subject matter of the claims, in an effort to further prosecution of the above-captioned application, Applicant are submitting a Terminal Disclaimer herewith.

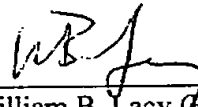
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CONCLUSION

Based on the remarks set forth above, Applicants believe that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' attorney would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

No fee, other than the \$130.00 for the Terminal Disclaimer, is believed to be due for this submission (because the 3-month date of February 12, 2005 fell on a Saturday). Should any other required fees be due, however, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,



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